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Filing date: **06/10/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92053336
Party	Defendant J.B. Custom, Inc.
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Submission	Motion to Suspend for Civil Action
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Date	06/10/2011
Attachments	Braztech Motion to Suspend with Exhibit.pdf ( 27 pages )(3447215 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF TRADEMARK REG. NO. 3,645,700

Filed: April 17, 2008

Registration Date: June 30, 2009

Braztech International, L.C. )

)

Petitioner, )

)

v. )

)

Cancellation No. 92053336

J.B. Custom, Inc. )

)

Registrant. )

**MOTION TO SUSPEND CANCELLATION PROCEEDINGS**

Commissioner for Trademarks

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Alexandria, VA 22313-1451

COMES NOW Registrant J.B. Custom Inc., (“JB”), by counsel, and, pursuant to Trademark Rule of Practice 2.117(a), Trademark Trial and 37 C.F.R. § 2117(a), moves to suspend the present cancellation pending final determination of a civil action having a bearing on the case, namely *J.B. Custom, Inc. v. Braztech, L.C. et. al.*, 1:10-cv-326 (N.D. Ind. 2011)(Second Amended Complaint attached hereto as Exhibit “A”).

On September 9, 2010, Registrant filed in the federal District Court for the Northern District of Indiana a Complaint alleging, *inter alia*, infringement by Petitioner of the “Mare’s Leg” registered Mark at issue in this cancellation proceeding. On November 30, 2010, the instant cancellation Petition was filed.

On March 22, 2011, Registrant filed in the federal District Court for the Northern District of Indiana a Second Amended Complaint, attached hereto as Exhibit “A.” The

Second Amended Complaint alleged, *inter alia*: (1) that Registrant is the owner of the “Mare’s Leg” mark with exclusive rights to use that mark; (2) that Petitioner engaged in past and present acts of infringement of the “Mare’s Leg” mark; and (3) that Petitioner intended to infringe the Mare’s Leg Mark in the future. The Seconded Amended Complaint requests relief against Petitioner including an injunction prohibiting Petitioner from future uses of the Mare’s Leg Mark.

In its Petition for Cancellation, Petitioner claims that it is and will be damaged by Registrant’s “Mare’s Leg” mark because it has, and intends to, offer goods in commerce using the term “mare’s leg” in a manner likely to cause confusion among consumer. This is the same conduct alleged as infringement and a basis for injunctive relief in Registrant’s Second Amended Complaint. Petitioner further alleges in this proceeding that Registrant’s “Mare’s Leg” mark is generic. Genericity will necessarily be decided in the civil action in connection with Registrant’s claims of Petitioner’s infringement.

Accordingly, the pending civil action will bear on issues involved in this proceeding, namely whether Petitioner has been harmed by Registrant’s use of the “Mare’s Leg trademark,” questions of ownership and priority of use, and whether Registrant’s “Mare’s Leg” mark is generic. The determination of these issues by the District Court will likely be dispositive of the issues involved in this proceeding. No dispositive motion has yet been filed in the present proceedings.

Registrant therefore respectfully requests suspension of these proceedings pending determination of the civil action pursuant to Trademark Rule 2.117(a) and 37 C.F.R. § 2.117(a). *Whopper-Burger v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (T.T.A.B. 1971).

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*Attorneys for J.B. Custom, Inc.*

**CERTIFICATE OF SERVICE**

I hereby certify that I have this 10th day of June, 2011, served a copy of the foregoing via electronic mail, properly addressed, to:

Kerri A. Hochgesang  
Smith, Gambrell & Russell LLP  
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1230 Peachtree St. NE  
Atlanta, GA 30309-3592

/Jeremy N. Gayed/  
Jeremy N. Gayed

**IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF INDIANA  
FORT WAYNE DIVISION**

J.B. CUSTOM, INC.

Plaintiff,

v.

Case No: 1:10-cv-326-PPS

AMADEO ROSSI S.A., FORJAS  
TAURUS S.A., TAURUS  
INTERNATIONAL MANUFACTURING,  
INC., AND BRAZTECH  
INTERNATIONAL, L.C.

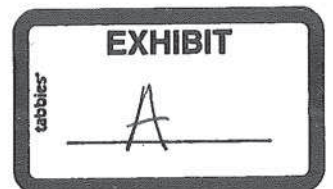
Defendants.

**SECOND AMENDED COMPLAINT**

COMES NOW Plaintiff, J.B. Custom, Inc. ("J.B. Custom"), by counsel, Barrett & McNagny, LLP, and for its Second Amended Complaint against Defendants, Amadeo Rossi S.A., Forjas Taurus S.A., Braztech International L.C., and Taurus International Manufacturing, Inc., alleges and states as follows:

**Parties, Jurisdiction, & Venue**

1. Plaintiff J.B. Custom, Inc. is an Indiana corporation with its principal place of business in Huntertown, Indiana.
2. Defendant Taurus International Manufacturing, Inc. ("Taurus USA") is a Florida corporation with its principal place of business at 16175 NW 49<sup>th</sup> Avenue, Miami, Florida.
3. On information and belief, Taurus USA is a subsidiary of Defendant Forjas Taurus, S.A.
4. On information and belief, Taurus USA, operating at the direction and control of Forjas Taurus, manufactures and assembles firearms for distribution and sale in the United States, including the Northern District of Indiana.



5. Defendant Forjas Taurus, S.A. ("Forjas Taurus") is a Brazilian corporation with its principal place of business at Avenida de Forte, 511, Porto Alegre/RS, Brazil.
6. Forjas Taurus owns subsidiaries throughout the United States of America, including, on information and belief, Taurus USA and Defendant Braztech, L.C.
7. On information and belief, Forjas Taurus has and continues to manufacture, assemble, and import into the Northern District of Indiana firearms, and, through its subsidiaries and controlled entities, has advertised and sold such firearms in the Northern District of Indiana using trade names and trade dress confusingly similar to trademark and trade dress rights owned by Plaintiff.
8. On information and belief, Forjas Taurus has further acted in the Northern District of Indiana in breach of contractual obligations to Plaintiff, and has directed its subsidiaries and controlled entities, including Taurus USA, Amadeo Rossi, S.A., and Braztech, L.C., to engage in acts that would result in breaches of its obligations to Plaintiff.
9. Defendant Amadeo Rossi S.A. ("Rossi") is a Brazilian corporation with its principal place of business at Caixa Postal 28, 93030-220, Sao Leopoldo/RS, Brazil.
10. In 2006, Rossi entered into a contract with Plaintiff in the Northern District of Indiana (the "Exclusivity Agreement").
11. Under the Exclusivity Agreement, Rossi agreed that Plaintiff had the right to serve as the exclusive importer for Rossi firearms of designs conceived by Plaintiff.
12. Rossi subsequently breached the Exclusivity Agreement by using other entities to import into the United States and the Northern District of Indiana firearm designs conceived by Plaintiff, said breach occurring in the Northern District of Indiana.



13. On information and belief, in 2008, Forjas Taurus acquired the assets of Rossi. On information and belief, Forjas Taurus at that time acquired Rossi's obligations to Plaintiff under the Exclusivity Agreement, in addition to the right to sell certain products bearing the "Rossi" name.
14. On information and belief, Rossi remains an entity actively advertising and selling handguns in the United States and the Northern District of Indiana at the direction and control of Forjas Taurus.
15. Rossi products are marketed in the United States and the Northern District of Indiana under the brand name "Rossi USA."
16. On information and belief, Rossi's breach of its contractual obligations to Plaintiff occurred at the direction of Forjas Taurus.
17. On information and belief, Rossi has advertised, promoted, and sold firearms in the Northern District of Indiana using trade names and trade dress confusingly similar to trademark and trade dress rights owned by Plaintiff.
18. Defendant Braztech International, L.C. ("Braztech") is a limited liability corporation organized under Florida law with its principal place of business at 16175 NW 49<sup>th</sup> Avenue, Miami, Florida.
19. On information and belief, Braztech was created and continues to operate as the exclusive U.S. importer of firearm products bearing the "Rossi" brand.
20. On information and belief, Braztech is a subsidiary of Forjas Taurus, or, alternatively, an entity operating under the control of Forjas Taurus.

21. On information and belief, Braztech has imported, distributed, and sold firearms in the Northern District of Indiana using trade names and trade dress confusingly similar to trademark and trade dress rights owned by Plaintiff.
22. Pursuant to 28 U.S.C. § 1331, this court has subject matter jurisdiction over Plaintiff's claims against Defendants arising under federal law.
23. There is complete diversity of citizenship between Plaintiff and all defendants and the amount in controversy exceeds \$75,000.
24. Pursuant to 28 U.S.C. § 1332, this Court has subject matter jurisdiction in diversity over Plaintiff's state-law claim against Defendants, as well as ancillary jurisdiction over the same.
25. Each Defendant has purposefully availed itself of the privilege of conducting business in the Northern District of Indiana by advertising, importing, selling, or offering for sale products in this District, or manufacturing and assembling products to be offered for sale in this District, including the firearms at issue in this litigation.
26. The contract at issue in this litigation was entered into in Huntertown, Indiana, in the Northern District of Indiana.
27. The acts of breach committed by Forjas Taurus and Rossi, in part through Forjas Taurus subsidiaries Taurus USA and Braztech, occurred throughout the United States, including in the Northern District of Indiana.
28. The advertisements, sales, and offers to sell firearms in breach of Plaintiff's trademark and trade dress rights occurred in the Northern District of Indiana.
29. Venue is proper under 28 U.S.C. §§ 1391(b) and (c).



### **Facts**

30. Plaintiff incorporates the allegations contained in Paragraphs 1-29 as if fully stated herein.
31. Plaintiff is a custom firearm manufacturer who designs and sells unique firearms and firearm services, including a custom lever-action pistol of unique and distinctive design and overall appearance that Plaintiff advertises and sells as the "Mare's Leg."
32. Plaintiff further offers custom gunsmithing services, including custom-modified lever-action pistols sold under the "Mare's Leg" mark.
33. Plaintiff's firearms, firearm designs, and firearm services have gained substantial goodwill in the market, particularly lever-action pistols manufactured or customized according to Plaintiff's distinctive design.
34. Plaintiff currently sells such lever-action pistols at a retail price of \$1,695.
35. On or around February 10, 2006, Plaintiff and Rossi executed in the Northern District of Indiana the Exclusivity Agreement, wherein Rossi agreed to produce and sell firearms of similar shape, appearance, and design to those developed and conceived by Plaintiff, and to allow Plaintiff to be the exclusive importer such firearms in the United States. A true and accurate copy of the Exclusivity Agreement is attached hereto as Exhibit A.
36. On information and belief, Forjas Taurus acquired and assumed Rossi's obligations under the Exclusivity Agreement in 2008.
37. Plaintiff is the registrant of the United States trademark for "Mare's Leg," registration number 3645700, registered with the United States Patent and Trademark Office on June 30, 2009. A true and accurate copy of the federal trademark registration for the "Mare's Leg" mark is attached hereto as Exhibit B.

38. Plaintiff sells and advertises its distinctive firearms, accessories, and firearm and gunsmithing services nationally and internationally using the "Mare's Leg" mark.
39. In addition to Plaintiff's federal registration of the "Mare's Leg" mark, Plaintiff has established common-law rights in the use of the "Mare's Leg" mark in conjunction with sales of lever-action pistols, lever-action pistol accessories, gunsmithing and firearm-related services.
40. Plaintiff has further established trade dress rights in the distinctive shape, design, and overall appearance of its lever-action pistols and lever-action pistols customized according to Plaintiff's design.
41. In the July 2010 issue of American Rifleman magazine, Rossi promoted a lever-action pistol called the "Ranch Hand," for a retail price of \$536.
42. The Ranch Hand is a lever-action pistol that is virtually identical in shape, design, and overall appearance to lever-action pistols of Plaintiff's distinctive design.
43. The July 2010 American Rifleman issue included a "product review" of the Ranch Hand that referred to the Ranch Hand as a "mare's leg."
44. On information and belief, some contents of the product review, including the reference to the Ranch Hand as a mare's leg version, were provided by Rossi, occurred as a result of Rossi's input, or were subject to Rossi's direction and control.
45. American Rifleman magazine is a National Rifle Association publication with a nationwide circulation, including substantial circulation in the Northern District of Indiana.
46. In other advertising, including on its website, Rossi has promoted and advertised the Ranch Hand as a "Mare's Leg."

47. Rossi's website is accessible nationwide, and is accessible in the Northern District of Indiana.
48. The Ranch Hand is a firearm of a design conceived by Plaintiff within the terms of the Exclusivity Agreement.
49. Neither Rossi nor any other Defendant to this action has used or is using Plaintiff as an importer for the Ranch Hand.
50. Forjas Taurus has and continues to manufacture, assemble, and import Ranch Hand firearms into the United States and the Northern District of Indiana.
51. Taurus USA has and continues to manufacture, assemble, and distribute Ranch Hand firearms in the United States and the Northern District of Indiana.
52. Rossi has advertised, promoted, sold, and offered for sale Ranch Hand firearms in the United States and the Northern District of Indiana.
53. Rossi further has advertised and promoted Ranch Hand firearms as "mare's legs."
54. Braztech has and continues to accept Ranch Hand rifles for importation into the United States, and has and continues to distribute Ranch Hand rifles for sale throughout the United States, including into the Northern District of Indiana.
55. On November 30, 2010, Braztech filed a Petition to Cancel Plaintiff's registration for the "Mare's Leg" trademark, which such Petition is pending. In its Petition, Braztech alleges that it "desires to refer to its mare's-leg type firearms by the term 'mare's leg.'" *In re Trademark Reg. No. 3,645,700*, Petition at ¶ 3 (TTAB 2010).
56. Forjas Taurus has manufactured, assembled, and imported Ranch Hand firearms, and directed Rossi and Taurus USA, in their manufacture, distribution, advertisement, sale,



and offers for sale of Ranch Hand firearms; in the United States and the Northern District of Indiana.

57. Forjas Taurus has directed Rossi in its advertisement and promotion of Ranch Hand firearms as “mare’s legs.”
58. Braztech has imported and distributed firearms that have been advertised as “mare’s legs” and that embody the distinctive shape, design, and overall appearance of lever-action pistols of Plaintiff’s design.
59. Braztech has further averred before the Trademark Trial and Appeal Board that it intends to advertise, promote, and sell lever-action pistols in commerce as “mare’s legs.”

#### **Count I: Breach of Contract**

60. Plaintiff incorporates by reference the allegations made in Paragraphs 1-59 as if fully stated herein.
61. Plaintiff entered into the Exclusivity Agreement with Rossi on February 10, 2006.
62. Under the Exclusivity Agreement, Rossi agreed to use Plaintiff as the exclusive importer of firearms with designs conceived by Plaintiff.
63. Plaintiff complied with its obligations under the Exclusivity Agreement.
64. Among the firearm designs conceived by Plaintiff is a lever-action pistol design advertised and sold by Plaintiff as a “Mare’s Leg.” (“Plaintiff’s Design”).
65. The Ranch Hand is a lever-action pistol virtually identical in design, shape, and overall appearance to Plaintiff’s Design.
66. Rossi has used importers other than Plaintiff in connection with importation, sale, and distribution of the Ranch Hand, in breach of the Exclusivity Agreement.

67. In 2008, on information and belief, Forjas Taurus acquired Rossi's obligations under the Exclusivity Agreement.
68. Forjas Taurus has used importers other than Plaintiff in connection with importation, sale, and distribution of the Ranch Hand, in breach of the Exclusivity Agreement.
69. Taurus USA is a subsidiary of Forjas Taurus. On information and belief, acting at the direction of and in concert with Forjas Taurus and Rossi, Taurus USA participated in and assisted with the breaches of contract of Rossi and Forjas Taurus, including by manufacturing or assembling firearms for distribution and sale in breach of the Exclusivity Agreement.
70. Braztech is the exclusive importer of Rossi products, and, on information and belief, is a subsidiary or entity substantially under the control of Forjas Taurus.
71. On information and belief, acting at the direction of and in concert with Forjas Taurus and Rossi, Braztech participated in and assisted with the breaches of contract of Rossi and Forjas Taurus, including by importing firearms in breach of the Exclusivity Agreement.
72. Plaintiff has been damaged by Defendants' acts and breaches of the Exclusivity Agreement.

WHEREFORE Plaintiff, J.B. Custom, seeks damages for Defendants' breach in an amount to be determined at trial, injunctive relief, interest, attorney's fees, and all other just and proper relief.

#### **Count II: Trademark and Trade Dress Infringement**

73. Plaintiff incorporates by reference the allegations made in Paragraphs 1-72 as if fully stated herein.



74. Plaintiff owns federal and state trademark rights in the “Mare’s Leg” trademark.
75. Defendants Forjas Taurus and Rossi have wrongfully used the term “mare’s leg” in advertisements, websites, and promotional materials for firearms and firearm-related services, including for the Ranch Hand.
76. The conduct of Forjas Taurus and Rossi is likely to cause consumers to confuse the Ranch Hand with lever-action pistols and firearms services offered in commerce by Plaintiff.
77. The conduct of Forjas Taurus and Rossi is further likely to cause consumers to confuse the Ranch Hand with lever-action pistols that have been the subject of Plaintiff’s gunsmithing services.
78. The conduct of Forjas Taurus and Rossi constitutes infringements of Plaintiff’s federal and state trademark rights in “mare’s leg.”
79. Forjas Taurus has directed Rossi and Taurus USA, and acted in concert with Rossi and Taurus USA, in their infringements of Plaintiff’s trademark rights.
80. Forjas Taurus manufactures, assembles, and distributes for sale Ranch Hand firearms.
81. Forjas Taurus knew and knows that the Ranch Hand pistols it manufactures, assembles, and distributes have been advertised and promoted as “mare’s legs” in violation of Plaintiff’s trademark rights.
82. Forjas Taurus has contributorily infringed Plaintiff’s rights in its “mare’s leg” mark.
83. Braztech has stated in filings before the Trademark Trial and Appeal Board its intention to use the term “mare’s leg” in connection with sales of lever-action pistol firearms.

84. Braztech's intention to use "mare's leg" in connection with lever action pistols, if acted upon, would likely cause consumers to confuse such lever-action pistols with lever-action pistols and services offered in commerce by Plaintiff.
85. Braztech's intention to use "mare's leg" in connection with lever action pistols, if acted upon, would further be likely to cause consumers to confuse Braztech's lever-action pistols with lever-action pistols that have been the subject of Plaintiff's gunsmithing services.
86. Braztech has acted in concert with Forjas Taurus, Rossi, and Taurus USA, in their infringements of Plaintiff's trademark rights, including by importing and distributing firearms that have been advertised and promoted as "mare's legs."
87. Braztech knew and knows that the Ranch Hand pistols it imports have been advertised and promoted as "mare's legs" in violation of Plaintiff's trademark rights.
88. Braztech has contributorily infringed Plaintiff's rights in its "mare's leg" trademark.
89. Taurus USA has and continues to manufacture, assemble, and distribute for sale Ranch Hand firearms in the United States and the Northern District of Indiana.
90. Taurus USA knew and knows that the Ranch Hand pistols it manufactures, assembles, and distributes have been advertised and promoted as "mare's legs" in violation of Plaintiff's trademark rights.
91. Taurus USA has contributorily infringed Plaintiff's rights in its "mare's leg" trademark.
92. Defendants' wrongful uses of the term "mare's leg" are likely to create confusion as to the origin of firearms advertised and sold by Defendants, or alternatively, to destroy the origin-identifying function of Plaintiffs' mare's leg mark.

93. Plaintiff further owns trade dress rights in the distinctive shape, design, and overall appearance of certain lever-action pistol designs.
94. The shape, design, and overall appearance of lever-action pistols of Plaintiff's Design are distinctive and have acquired secondary meaning such that consumers identify lever-action pistols of such shape, design, and overall appearance with Plaintiff.
95. The identifying aspects of lever-action pistols of Plaintiff's Design are not functional.
96. The Ranch Hand has a shape, design, and overall appearance that is similar to the distinctive shape, design, and overall appearance of lever-action pistols of Plaintiff's Design.
97. Due to the similarity in the shape, design, and overall appearance of the Ranch Hand with the shape, design, and overall appearance of Plaintiff's Design, consumers are likely to confuse the Ranch Hand with lever-action pistols sold by Plaintiff.
98. Due to the similarity in the shape, design, and overall appearance of the Ranch Hand with the shape, design, and overall appearance of Plaintiff's Design, consumers are likely to confuse the Ranch Hand with lever-action pistols that have been the subject of Plaintiff's gunsmithing services.
99. Forjas Taurus and Rossi have wrongfully advertised and sold Ranch Hand firearms in the United States and the Northern District of Indiana in violation of Plaintiff's trade dress rights.
100. Forjas Taurus has and continues to manufacture, assemble, and import Ranch Hand firearms into the United States and the Northern District of Indiana.
101. Forjas Taurus knew and knows that the Ranch Hand firearms it manufactures, assembles, and imports infringe and violate Plaintiff's trade dress rights.



102. Forjas Taurus has and continues to contributorily infringe Plaintiff's trade dress rights.
103. Taurus USA has and continues to manufacture, assemble, and distribute Ranch Hand firearms in the United States and the Northern District of Indiana.
104. Taurus USA knew and knows that the Ranch Hand firearms it manufactures, assembles, and distributes infringe and violate Plaintiff's trade dress rights.
105. Taurus USA has and continues to contributorily infringe Plaintiff's trade dress rights.
106. Braztech has and continues to import and distribute firearms that infringe Plaintiff's trade dress rights.
107. Braztech knew and knows that the Ranch Hand firearms it imports infringe and violate Plaintiff's trade dress rights.
108. Braztech has and continues to contributorily infringe Plaintiff's trade dress rights.
109. Defendants' wrongful advertising and sale of firearms that infringe Plaintiff's trade dress rights are likely to create confusion as to the origin of firearms advertised and sold by Defendants, or, alternatively, to destroy the origin-identifying function of Plaintiff's proprietary trade dress.
110. Defendants have infringed Plaintiff's trademark and trade dress rights in violation of the Lanham Act, 15 U.S.C. § 1114.
111. Defendants have further infringed Plaintiff's state trademark and trade dress rights.
112. Due to Defendants' conduct, Plaintiff has suffered and will continue to suffer damage to its business, goodwill, reputation, profits, and the strength of its trademark and trade dress rights.

113. Plaintiff's injuries are ongoing and irreparable. An award of monetary damages alone cannot fully compensate Plaintiff for its injuries, and Plaintiff lacks an adequate remedy at law.

WHEREFORE Plaintiff, J.B. Custom, requests an injunction prohibiting further infringements of its rights, an injunction against Braztech prohibiting it from acting on its intention to infringe Plaintiff's rights, as well as all other remedies available under the Lanham Act, including compensatory damages, statutory damages, disgorgement of profits, costs, and attorney's fees.

**Count III: False Designation of Origin**

114. Plaintiff incorporates by reference the allegations contained in Paragraphs 1-113 as if fully stated herein.

115. Plaintiff's "Mare's Leg" trademark, as used by Plaintiff in connection with the sale of lever-action pistols, lever-action pistol accessories, and gunsmithing services, is a distinctive mark and has become associated with Plaintiff.

116. The advertisement, promotion, and sale of Ranch Hand firearms as "mare's legs" by Forjas Taurus and Rossi, and the intended sale by Braztech of lever-action pistols advertised as "mare's legs," as described previously in this Complaint, are or would be likely to cause confusion and mislead consumers to believe that firearms such as the Ranch Hand originate from Plaintiff, in violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), and state law.

117. The advertisement, promotion, and sale of Ranch Hand firearms as "mare's legs" by Forjas Taurus and Rossi, and the intended sale by Braztech of lever-action pistols advertised as "mare's legs," as described previously in this Complaint, will or would



cause consumers to believe that Plaintiff's "mare's leg" mark is generic, thus destroying the goodwill and value that Plaintiff has built around the mark.

118. The advertisement, promotion, and sale of Ranch Hand firearms as "mare's legs" by Forjas Taurus and Rossi, and the intended sale by Braztech of lever-action pistols advertised as "Mare's Legs," as described previously in this Complaint, have or would false designation of origin in violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).
119. The distinctive shape, design, and overall appearance of lever-action pistols of Plaintiff's Design constitutes a distinctive identifying mark associated with Plaintiff.
120. The advertisement, promotion, and sale of Ranch Hand firearms by Forjas Taurus and Rossi, as described previously in this Complaint, is likely to cause confusion and mislead consumers to believe that firearms such as the Ranch Hand originate from Plaintiff, in violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), and state law.
121. The advertisement, promotion, and sale of Ranch Hand firearms by Forjas Taurus and Rossi, as described previously in this Complaint, will cause consumers to believe that the distinctive shape, design, and overall appearance of lever-action pistols of Plaintiff's Design is generic, thus destroying the goodwill and value that Plaintiff has built around its trade dress.
122. The advertisement, promotion, and sale of Ranch Hand firearms by Forjas Taurus and Rossi, as described previously in this Complaint, constitutes false designation of origin in violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).
123. This conduct has caused irreparable injury to Plaintiff's goodwill and reputation. The injury to Plaintiff is ongoing and irreparable. An award of monetary damages alone

cannot fully compensate J.B. Custom for its injuries, and J.B. Custom lacks an adequate remedy at law.

WHEREFORE Plaintiff, J.B. Custom, requests an injunction prohibiting further infringements of its rights, an injunction against Braztech prohibiting it from acting on its intention to infringe Plaintiff's rights, as well as all other remedies available under the Lanham Act, including, but not limited to, compensatory damages, treble damages, disgorgement of profits, and costs and attorney's fees.

#### **Count IV: Passing Off**

124. Plaintiff incorporates by reference the allegations contained in Paragraphs 1-123 as if fully stated herein.
125. Plaintiff's Mare's Leg trademark is a distinctive mark and has become associated with Plaintiff for gunsmithing services, lever-action pistol firearms of Plaintiff's Design, and firearm accessories.
126. The overall shape, appearance, and design of lever-action pistols of Plaintiff's Design are distinctive, have acquired secondary meaning, have become associated with Plaintiff to consumers, and are subject to trade dress rights owned by Plaintiff.
127. The advertisements and promotions of Ranch Hand firearms using the term "mare's leg" by Forjas Taurus and Rossi, and the intended use of "mare's leg" by Braztech, as described previously in this Complaint, are or would be likely to cause confusion and mislead consumers to believe that firearms including the Ranch Hand are made, sponsored, or otherwise approved by Plaintiff in violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) and state law.



128. The manufacture, assembly, advertisement, importation, distribution, and sale of firearms with overall shape, design, and appearance confusingly similar to Plaintiff's Design in violation of Plaintiff's dress rights, as described previously in this Complaint, are likely to cause confusion and mislead consumers to believe that the firearms including the Ranch Hand are made, sponsored, or otherwise approved by Plaintiff in violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) and state law.
129. The advertisement and promotion of Ranch Hand firearms using the term "mare's leg" by Forjas Taurus and Rossi, and the intended use of "mare's leg" by Braztech "mare's leg," as described previously in this Complaint, will or would cause consumers to believe that Plaintiff's "Mare's Leg" mark is generic, thus destroying the goodwill and value that Plaintiff has built in connection with the "mare's leg" trademark.
130. The manufacture, assembly, advertisement, importation, distribution, and sale of firearms confusingly similar to Plaintiff's Design in violation of Plaintiff's dress rights, as described previously in this Complaint, will cause consumers to believe that the distinctive shape, design, and overall appearance of lever-action pistols of Plaintiff's Design is generic, thus destroying the goodwill and value that Plaintiff has built in connection with its trade dress.
131. These acts and conduct constitute or would constitute passing off in violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).
132. Defendants' conduct has caused irreparable injury to J.B. Custom's goodwill and reputation. The injury to Plaintiff is ongoing and irreparable. An award of monetary damages alone cannot fully compensate Plaintiff for its injuries, and Plaintiff lacks an adequate remedy at law.

WHEREFORE Plaintiff, J.B. Custom, requests an injunction prohibiting further infringements of its rights, an injunction against Braztech prohibiting it from acting on its intention to infringe Plaintiff's rights, as well as all other remedies available under the Lanham Act, including, but not limited to, compensatory damages, treble damages, disgorgement of profits, and costs and attorney's fees.

**Count V: False Advertising**

133. Plaintiff incorporates by reference the allegations contained in Paragraphs 1-132 as if fully stated herein.
134. Plaintiff's federally-registered "mare's leg" trademark is a distinctive trademark and has become associated with Plaintiff.
135. Plaintiff also owns state trademark rights in the term "Mare's Leg" as it is and has been used in commerce by Plaintiff in connection with lever-action pistols of Plaintiff's Design, custom gunsmithing services for the same, and lever-action pistol accessories.
136. Forjas Taurus and Rossi have wrongfully used and infringed Plaintiff's "Mare's Leg" trademark in advertisements, websites, and promotional materials for the Ranch Hand firearm, as described previously in this Complaint.
137. Braztech intends to wrongfully use and infringe Plaintiff's "Mare's Leg" trademark in advertisements and promotional materials for lever-action pistols, as described previously in this Complaint.
138. These wrongful uses and infringements of Plaintiff's "Mare's Leg" trademark contain or will contain false or misleading representations of material fact concerning the nature, characteristics, or qualities of products including the Ranch Hand firearm, and will specifically falsely promote that the such firearms are sponsored or approved by Plaintiff.



139. The advertisements, websites, and promotional materials of Forjas Taurus and Rossi, as described previously in this Complaint, will deceive or have a tendency to deceive a substantial segment of their audience regarding the nature, characteristics, or origin of the Ranch Hand firearm.
140. These advertisements and statements of fact do and will influence consumers' purchasing decisions for firearms and gunsmithing services.
141. The Ranch Hand and Plaintiff's lever-action pistols move in interstate commerce.
142. The foregoing advertisements, websites, and promotional materials constitute false advertising in violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).
143. This conduct, as set forth above, has and will directly diverted business from Plaintiff's products and services and has caused and will cause a loss of Plaintiff's goodwill and reputation in the market. This conduct has further caused and will cause a lessening of the acceptability that Plaintiff's products enjoy with the buying public.
144. The injury to Plaintiff from this conduct is ongoing and irreparable. An award of monetary damages alone cannot fully compensate Plaintiff for its injuries, and Plaintiff lacks an adequate remedy at law.

WHEREFORE Plaintiff, J.B. Custom requests an injunction prohibiting further infringements of its rights, an injunction against Braztech prohibiting it from acting on its intention to infringe Plaintiff's rights, as well as all other remedies available under the Lanham Act, including, but not limited to, compensatory damages, treble damages, disgorgement of profits, and costs and attorney's fees.



**Count VI: Unfair Competition**

145. Plaintiff incorporates by reference the allegations made in Paragraphs 1-144 as if fully stated herein.
146. Plaintiff has and continues to design, develop, advertise, manufacture, assemble, and sell lever-action pistols embodying the distinctive overall shape, design, and appearance of Plaintiff's Design.
147. Plaintiff has a federally registered trademark for "mare's leg," and has further established common law state trademark rights in the term "mare's leg, in connection with the sale of its lever-action pistols, accessories, gunsmithing, and custom firearm products and services.
148. Plaintiff further has established trade dress rights in the distinctive overall shape, design, and appearance of lever-action pistols of Plaintiff's Design.
149. As described in detail with respect to each individual Defendant previously in this Complaint, the Defendants in this litigation have participated in direct or contributory infringements of Plaintiff's trademark and trade dress rights, as well as breaches of the Exclusivity Agreement and interference with the same, as previously and particularly described.
150. The natural and probable effect of Defendants' conduct, as previously described, is to deceive the public so as to pass off the Ranch Hand as a J.B. Custom firearm.
151. The advertisement, promotion, and sale of the Ranch Hand as a "mare's leg" constitutes an attempt to create confusion in the purchasing public as to the source of the Ranch Hand.

152. The advertisement, promotion, and sale of the Ranch Hand, which retails at a lesser price than Plaintiff's lever-action pistols, is calculated to divert business away from Plaintiff.
153. These actions, each of them, constitute unfair competition under Indiana law.

WHEREFORE Plaintiff, J.B. Custom requests an injunction prohibiting further infringements of its rights, an injunction against Braztech prohibiting it from acting on its intention to infringe Plaintiff's rights, as well as all other remedies available under Indiana law including, but not limited to, compensatory damages, treble damages, disgorgement of profits, and costs and attorney's fees.

Respectfully submitted,

BARRETT & MCNAGNY LLP

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**ROSSI**  
FIREARMS

**AMADEO ROSSI S.A.**  
metalúrgica e munições

RUA AMADEO ROSSI, 143 --- CAIXA POSTAL 28  
93030-220 - SÃO LEOPOLDO - RS

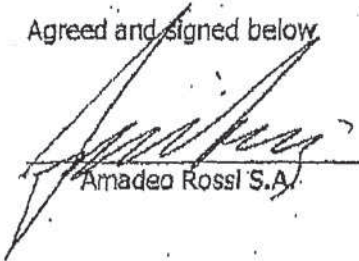
PLEASE ADDRESS ALL CORRESPONDENCE TO P.O. BOX, 28  
03030-220 - SÃO LEOPOLDO - RS - BRASIL  
TELEX: 624011 ARMM BR  
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FAX: (051) 590.1121...

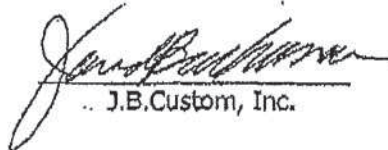
### Exclusivity Agreement

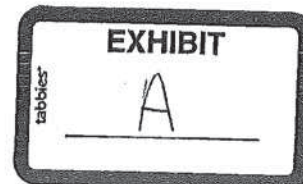
This will confirm the agreement between Amadeo Rossi S.A. (Brazil) and J.B Custom, Inc. (USA) that Amadeo Rossi S.A. will produce and sell firearms developed and conceived by J.B Custom, Inc. such as Mares Leg Lever Action Pistol with exclusivity in USA to J.B Custom, Inc. This agreement is valid for one-year period and will be automatically renewed for the same period since both parties agree on a written communication that must be signed 30 days before expiration of the present agreement. This agreement may be terminated by either party for reasonable cause with six month's notice.

Dated: 02/10/2006

Agreed and signed below

  
Amadeo Rossi S.A.

  
J.B. Custom, Inc.







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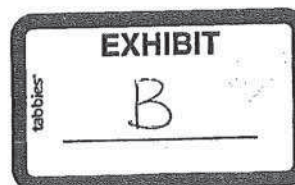
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# MARE'S LEG

Word Mark	MARE'S LEG
Goods and Services	IC 040. US 100 103 106. G & S: CUSTOM MANUFACTURING OF FIREARMS AND ACCESSORIES FOR FIREARMS. FIRST USE: 20000604. FIRST USE IN COMMERCE: 20000810
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Trademark Search Facility Classification Code	NOTATION-SYMBOLS Notation Symbols such as Non-Latin characters,punctuation and mathematical signs,zodiac signs,prescription marks
Serial Number	77450968
Filing Date	April 17, 2008
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	April 14, 2009
Registration Number	3645700



case 1:10-cv-00326-PPS -RBC document 1 filed 09/20/10 page 15 of 15  
Trademark Electronic Search System (TESS) Page 2 of 2

Registration Date June 30, 2009  
Owner (REGISTRANT) J.B. CUSTOM, INC. CORPORATION INDIANA 1820 FLAUGH RD. FORT WAYNE INDIANA 46818  
Type of Mark SERVICE MARK  
Register PRINCIPAL  
Live/Dead Indicator LIVE

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